

Appl. No. 09/472,762
Amdt. dated August 06, 2003
Reply to Office action of May 7, 2003

REMARKS

The Office Action mailed May 7, 2003 has been carefully considered. Reconsideration of this application in view of the following remarks is respectfully requested.

The Claims

Claims 1 – 8, including independent claims 1, 3, 5 and 7, are pending in this application. No claims have been amended in this paper. A listing of all claims that have ever been presented in this application, with line numbering, has been provided as a courtesy to the Examiner.

35 USC § 102

In the Office Action, Claims 1, 3 and 5 were rejected, in paragraph 3, under 35 U.S.C. § 102(e) as being anticipated by Schoen (US 5,991,709). Anticipation under 35 U.S.C. § 102 requires that each and every claim limitation be disclosed by the applied reference. In fact, as stated in MPEP 2131, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim,” citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In the context of court review of a defense to infringement on the grounds that a patent was invalid due to lack of novelty under 35 U.S.C. § 102, the Federal Circuit has said, “[w]hen the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device.” *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349, 48 USPQ2d 1225, 1229-30 (Fed. Cir. 1998). Applying that standard to the subject application, to make a *prima facie* case of anticipation, the Examiner must show that the Schoen reference describes all of the elements of claims 1, 3 and 5, arranged as in those claims. As the MPEP further notes, “[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis*

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verbis test, i.e., identity of terminology is not required," citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is respectfully submitted that the Schoen reference does not teach each and every claim limitation of claims 1, 3 and 5, as arranged in those claims, and therefore, as a matter of law, cannot anticipate the claims of the subject invention.

The claim limitations of the subject invention.

Independent claim 1 of the present invention is directed to a computer-implemented method that requires

loading a document into storage, said document having a category,
determining the document category,
receiving at least one processing rule, wherein the rule is associated
with the document category; and
processing the document according to the processing rule.

In claim 1, the "document" element referred to in the loading and processing steps is the same document. That is, the document that is loaded into storage is the one for which the document category is determined, and is the document that is processed according to the processing rule associated with the document category. In addition, it can be seen from the order of the steps that the step of determining the document category precedes processing the document according to the processing rule.

Independent claim 3, directed to a computer system, and independent claim 5, directed to a computer program, have limitations and meaning similar to claim 1. Thus, the discussion below, while referring to independent claim 1, applies equally to claims 3 and 5.

Independent claim 7 is directed to a method for transferring a computer program product from one or more first computers to a second computer connected to the one or more first computers through a communications medium. The computer program product includes computer-executable instructions that

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perform the steps that are included in independent claim 1, and so the discussion below, while referring to independent claim 1, also applies equally to claim 7.

Discussion of the teachings of the Schoen reference.

The Schoen reference discloses a computer system for automatically classifying or declassifying military, intelligence, government or industrial documents. (Abstract) Schoen discloses that

[t]his automated system inserts proper classification markings into the electronic version of the document, so that a final draft of the document can be rapidly produced for final approval and release by an appropriate program office official.

See col. 1, lines 39 – 43. Schoen summarizes the operation of the disclosed system as follows:

[t]he basic function of the DACS process is to convert document classification guidelines to classification "rules," which can be utilized by computer algorithms to electronically scan documents (to be processed for security marking) and automatically assign proper security markings to all material contained in the documents.

See col. 4, lines 50 – 55. There are two types of documents disclosed in Schoen:

- (1) a classification guidelines document, from which classification "rules" are produced (through various electronic processing means, including the use of artificial intelligence techniques, referred to in Schoen as the classification guidelines processor, CGP); see, e.g., col. 1, lines 64 – 67 and col. 2, lines 1 – 6; col. 5, lines 9 - 23; and Figures 3 and 5; and
- (2) documents that are to be processed for security markings (e.g., classified) using the "rules" produced from the classification guidelines document in a process referred to as the document classification processor, DCP; see, e.g., col. 2, lines 21 – 35; col. 5, lines 53 – 65, and Figures 4 and 6.

In the remainder of this discussion, these two different types of documents disclosed in the Schoen reference will be referred to as type (1) and type (2)

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documents. In Schoen, classification "rules" are produced first from a type (1) document, and then each type (2) document to be marked for a security level is electronically scanned, using the classification "rules", to find those portions that should be marked with an appropriate security classification.

Since it has already been pointed out above that the "document" referred to in the steps of claim 1 of the subject invention is the same document, it follows that, for the Schoen reference to teach each and every claim limitation of claim 1 in the subject invention as arranged in claim 1, Schoen must teach the elements of claim 1 for one of the two document types noted above.

So, for example and to emphasize the importance of this last point: It is respectfully submitted, that to make a *prima facie* case of anticipation, Schoen must disclose either "loading a type (1) document into storage, the type (1) document having a category" and "determining the document category" or "loading a type (2) document into storage, the type (2) document having a category" and "determining the document category." That is, claim 1 reads on either the processing of the classifications guideline document by the CGP subsystem or the processing of a document to be scanned for security markings by the DCP subsystem. A prima facie case of anticipation cannot be made by Schoen by a showing of the steps of claim 1 that involve the mixing of both types of documents.

a. The Schoen reference teaches a limited set of document "categories."

As a preliminary matter, a brief discussion is warranted about the term "classify". It is assumed that a central argument of the case of anticipation proposed in the Office Action is that Schoen teaches the step in claim 1 of the subject invention of "determining a document category" on the basis that type (2) documents processed by the DCP subsystem in Schoen are assigned one or more security classifications (i.e., "confidential", "secret", etc.). See, e.g., Figures 3 and 7. Figure 3 illustrates an embodiment of the classification guidelines process CGP output tables which includes a "classification" column indicating various levels of security assignments (e.g., "Confidential", "Secret", etc.). Figure

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7 shows a flowchart of a preferred embodiment of the software logic for the creation of the CGP output tables of Figure 3, and uses terms such as "secret" and "confidential" as key words in the processing logic.

It is respectfully submitted that this limited type of document categorization is the only reasonable interpretation to be derived from Schoen because Schoen discloses no other type of document categorization process. While Schoen does not appear to provide an explicit definition for the verb "classify" in the patent document, its meaning may be ascertained from an English language dictionary. For example, a dictionary available at <http://dictionary.reference.com>, citing the American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company, provides two definitions for classify:

1. To arrange or organize according to class or category.
2. To designate (a document, for example) as confidential, secret, or top secret.

There are numerous passages in the Schoen reference, in addition to those already cited above, that support the fact that Schoen teaches only the second definition of the word "classify." See, for example, col. 2, lines 45 – 52 where Schoen remarks

[t]he DACS capability is not limited to military or intelligence communities' security needs. There are similar needs in many government agencies with sensitive information (State Department, FBI, etc.) In addition, the industrial and financial markets typically deal with proprietary, confidential, and competition-sensitive information, which also needs to be properly identified and marked accordingly.

Thus, for purposes of discussing the case of anticipation proposed in the Office Action, it will be assumed herein that Schoen teaches the processing step of "determining a document category" on the basis of type (2) documents being processed by the DCP subsystem in Schoen in order to be assigned one or more security classifications (i.e., "confidential", "secret", etc.).

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b. The CGP subsystem defines the document "categories" while the DCP subsystem determines the document categories.

Claim 1 of the subject invention requires "loading a document into storage, the document having a category;" and "determining the document category." Since these elements refer to the same document (as noted in the discussion above), the document that is loaded into storage that has a document category is the one for which that document category is determined. The Office Action cites col. 1, lines 51 – 67, col. 2, lines 1 – 2, col. 4, lines 65 – 67, and col. 5, lines 1 – 8 as teaching "loading a document into storage." These passages teach the general loading or scanning of documents into computer storage, with reference to both type (1) and type (2) documents.

The Office Action, in paragraph 4 at page 2, cites, as teaching the step of "determining the document category," these passages: col. 2, lines 2-6, 9-11 and col. 5, lines 9 – 20. These passages describe the classification guidelines processor, or CGP subsystem, where the classifications guidelines document that contains information on how to assign security markings (a type (1) document in the terminology described above) is electronically processed to yield a set of rules that can be automatically applied to the type (2) documents to be marked with security markings. It is respectfully submitted that the CGP subsystem teaches producing the "rules" that define the categories of "confidential", "secret", etc., but does not itself "determine a document category." That is, if the only categorization that Schoen teaches is to assign security levels to a document, then the CGP subsystem that produces the classification "rules" to define the security levels could not also classify the classification document in the same process.

It is, in fact, the DCP subsystem, and not the CGP subsystem, that actually determines a document category for the type (2) documents that are scanned to be marked for security levels. In Schoen, each document is electronically scanned, using the classification "rules", to find those portions that should be marked with an appropriate security classification. See col. 4, lines 50 – 55; see

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also Figure 4, DCP Table 1, and col. 5, lines 53 – 65 ("[t]his table provides instructions to the publishing subsystem on how to mark each page of the document."). Figure 4 shows an embodiment for the document classification processor DCP output tables, showing the classification level ("confidential", "secret" etc.) of each portion (by page and paragraph) of a document.

It is respectfully submitted that, for the first two claim elements in claim 1, the Office Action makes a case of anticipation by piecing together processing steps using both types of documents.

- c. In Schoen, the "rules" obtained from first processing a type (1) document are then applied to a type (2) document in order to determine a document category.

The Office Action cites, for teaching the limitations of both receiving at least one processing rule wherein the rule is associated with the document category, and processing the document according to the processing rule, the following passages of Schoen: col. 2, lines 21-25, 27-32; col 5, lines 45-50, 53-62, col. 6, lines 29-35, 54 – 67, and col. 7, lines 1 – 20. The passages at col. 5, lines 45 – 50 and col. 7, lines 1 – 20 describe teachings that describe the rules used for classification purposes, and the remaining cited passages refer to the DCP subsystem for processing type (2) documents to assign security markings to portions thereof. For purposes of this discussion, assume that it is true that in the DCP subsystem a rule is "received" from the CGP output tables, which rule is "associated with a document category" (i.e., if the rule applies to a particular portion of the document, that document portion should be marked as "confidential"), and that rule is used to process the type (2) document. If the security classification process disclosed in Schoen could be considered as teaching the claim limitation of "determining a document category" of the present invention, then Schoen discloses that in order to determine the document's category, the system must first obtain the set of classification "rules", as produced by the CGP process, before a document can be classified with proper security

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markings, in the DCP process. See, for example, col. 5, lines 53 – 65 ("[t]he DCP software scans through the subject document to locate critical parameters and descriptors identified in the CGP tables.").

However, in claim 1 of the subject invention, the step of "determining the document category" has already occurred at the time the rule is received. In Schoen's DCP subsystem, the purpose of receiving the rule is to process the document according to the rule in order determine the document category (e.g., "confidential" or "secret", etc.) In Schoen, the system uses the rules to classify the document; the rule produces the classification. In the subject invention, the document category is determined first, which leads to receiving an associated rule.

It is respectfully submitted that the Office Action makes a case of anticipation only by piecing together processing steps using both types of documents, and puts these steps in a processing order different from that specified in claim 1. As noted above, the arguments made with respect to independent claim 1 apply equally to independent claims 3, 5 and 7.

d. Allowance of the claims in the subject invention would not exclude the public from practicing the invention disclosed in the Schoen reference.

The Federal Circuit has said,

[a]nticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. ... In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated.

Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).

This passage expresses the key public policies that support the anticipation rejection: a qualified prior art reference must not place the claims of the subject invention in possession of a person of ordinary skill in the art, such that the

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statutory requirement of novelty is not met, and granting a patent to the claims of the subject invention must not prevent the practice of the reference. And, of course, the further public policy rationale is that, under the U.S. patent law system, double patenting is not allowed, and only one patent may be granted to the same invention.

It is respectfully submitted that, in view of the above discussion of the Schoen reference, that reference may be read to teach two different methods to process type (1) and type (2) documents, neither of which is the method set forth in independent claim 1.

For type (1) documents, the Schoen reference teaches:

loading a type (1) document into storage, said document having classification guidelines, and
processing the type (1) document to produce a set of classification rules from the classification guidelines.

For type (2) documents, the Schoen reference teaches:

loading a type (2) document into storage
receiving at least one processing rule, wherein the rule is associated with a document category;
processing the type (2) document according to the processing rule in order to determine the document category.

Neither of these teachings for processing documents places the claims of the subject invention in possession of a person of ordinary skill in the art.

Moreover, claim 1 of the subject invention cannot be used to successfully process (classify) type (2) documents. Claim 1 would have to be modified to accept type (2) documents and require:

loading a type (2) document into storage, said type (2) document having a category,
receiving at least one processing rule (generated by the CGP system), wherein the rule is associated with [the] a document category; and

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processing the type (2) document according to the processing rule in order to determine the document category.

Thus, it can be seen that granting a patent to the claims of the subject invention will not prevent the practice of the reference.

For the foregoing reasons, is believed that independent claims 1, 3, 5 and 7 are not anticipated by the Schoen disclosure, and they are believed to be in condition for allowance. Insofar as claims 2, 4, 6, and 8, inclusive, are concerned, these claims all include the limitations of and depend from now presumably allowable claims 1, 3, 5 and 7.

35 USC § 103 and Independent Claim 7

In the Office Action, claim 7 was rejected, in paragraphs 6, 7 and 8, under 35 U.S.C. § 103 as being unpatentable over Schoen (US 5,991,709) for the same reasons cited in the §102 argument, and further in view of taking notice, at pages 4 – 5, that “[i]t is well known in the art to transfer data files and executable programs from one computer to another through a medium. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to transfer the computer-readable instruction contained in Schoen's system from one computer to another through a communication medium for sharing purposes.”

The patentability of claim 7 has already been argued above, in conjunction with the rejection of claims 1, 3 and 5 under 35 U.S.C. § 102(e). However, a brief comment is in order with respect to this rationale for transferring computer-readable instructions from one computer to another. It has been well-established that the system(s) described in Schoen deals with the classification of government, military, intelligence and other sensitive data. The Office Action acknowledges that Schoen appears to be silent with respect to the transfer of the computer-readable instructions in the CGP and DCP subsystems, but it seems unlikely, in a system that deals with the classification of sensitive documents, that a person of ordinary skill in the art would allow users to transfer these types of

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programs from one computer to another. The programs themselves are likely to be classified, and therefore greater control is probably asserted over their location and use. It is true that the transfer of computer-executable instructions from one computer to another is known in the art; however, it seems unlikely that a person of ordinary skill in the art would think of transferring among computers the programs disclosed in Schoen.

For the foregoing reasons, is believed that independent claim 7 is not obvious in view of the Schoen disclosure and the purportedly "well-known" practice in the art of transferring files, and is also believed to be in condition for allowance.

35 USC § 103 and Dependent Claims 2, 4, 6 and 8.

In the Office Action, dependent claims 2, 4, 6 and 8 were rejected, in paragraphs 9, 10 and 11 under 35 U.S.C. § 103 as being unpatentable over Schoen (US 5,991,709) for the same reasons cited in the §102 argument, and further in view of MacPhail, U.S. Patent 5,107,419. MacPhail is cited for teaching the processing rule including retention criteria for determining how long to save a document. The Office Action states, as motivation for the combination of Schoen and MacPhail, that "MacPhail's teaching of using retention criteria to determine whether documents stored exceeds expiration date can help the processing rule in Schoen's system to automatically delete documents that are no longer needed to save system storing space."

The patentability of claims 2, 4, 6 and 8 have already been argued above, in conjunction with the rejection of claims 1, 3 and 5 under 35 U.S.C. § 102(e). However, it is useful to comment on the proposed motivation for combining the Schoen and MacPhail references in this instance. As already noted, it has been well-established that the system(s) described in Schoen deals with the classification of government, military, intelligence and other sensitive data. The Office Action acknowledges that Schoen does not discuss determining retention criteria for these sensitive documents as one of the classification "rules" produced

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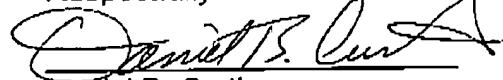
by the CGP subsystem. It is respectfully submitted that, with respect to sensitive (confidential, secret and top secret) documents, there is little motivation to apply a per se rule that determines how long to retain or when to delete a document at the same time the document is being classified (marked with security markings) or declassified. It would seem more likely that a retention plan for sensitive government documents might be the purview of Federal law that is separate and distinct from whether, or how much of, a document is classified or declassified. Or a retention plan for sensitive government documents might more plausibly be determined by subsequent events that influence the importance of the document.

Reconsideration Requested

The undersigned respectfully submits that, in view of the foregoing amendments and remarks, the rejections of the claims raised in the Office Action dated May 7, 2003 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that these claims be allowed, and that this case be passed to issue.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Applicant's attorney, Daniel Curtis, at Telephone Number (650) 812-4259, Palo Alto, California.

Respectfully submitted,



Daniel B. Curtis
Attorney for Applicant(s)
Registration No. 39,159
Telephone: 650-812-4259

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